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MD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/143,583	08/31/98	BOWERS C	30-2138CIP2

IM22/0222

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EXAMINER	
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ART UNIT	PAPER NUMBER
1733	6

DATE MAILED: 02/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/143,583	Applicant(s) Bowers
	Examiner Sam Chuan Yao	Group Art Unit 1733

☒ Responsive to communication(s) filed on *Aug 31, 1998* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-13* is/are pending in the application.

Of the above, claim(s) *4-13* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-3* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *2*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-3, 6-8, and 10-12, drawn to a process for producing a yarn, classified in class 57, subclass 328.

   II. Claims 4-5, 9 and 13, drawn to a yarn made by the process of Group I, classified in class 57, subclass 238.

2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case forming a yarn from a bundle of fiber and binder fibers using known yarn making techniques other than ring spinning or wrap spinning.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of

their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains method claims directed to the following patentably distinct species of the claimed invention. For this reason, the method claims are further subdivided into two subgroups.

Species IA: forming a yarn by ring spinning a bundle of fiber with binder fibers;

Species IB: forming a yarn by twisting two or more ring spun yarn with binder fibers; wherein the ring spun yarn is formed by ring spinning a fiber bundle.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Ms Virginia Andrew on 12-27-99 and on 02-15-00 a provisional election was made with traverse to prosecute the invention of Group I species IA, claims 1-3. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 18 and 21 of copending Application No. 08/933,822. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been an obvious expediency in the art to use a binder material having the recited melting range as such is well known in the art and because one in the art would have determined, by routine experimentation, a binder fiber material having a workable melting range for the process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lofquist (US 5,478,624).

Lofquist discloses a process of making synthetic yarn having a heat-activated binder fiber, the process comprises:

a) providing a bulk continuous filament base fiber,

b) commingling the heat-activated binder fibers with the bulk continuous base fiber to form a commingled yarn, the binder fibers have a melting range of 165-190°C;

c) twist-setting at least two yarns to form a plied yarn using a Suessen or Superba processes and the plied yarn comprises about 1-12% weight of binder fibers;

d) heating the plied yarn to melt the binder fibers; and then

e) cooling the heated yarn to harden the binder fibers (col. 1 line 62 to col. 2 line 22; col. 3 line 15 to col. 4 line 29; col. 7 line 35 to col. 8 line 17).

Lofquist does not expressly teach using either a ring spinning or wrap spinning technique to form the yarn which comprises the base fibers and the binder fibers. However, absent any showing of unexpected benefit/result, it would have been obvious in the art making the synthetic yarn of Lofquist to either ring spin or wrap spin the base fibers and the binder fibers together to form the yarn because it is conventional in the art to make yarns by either ring spinning method or wrap spinning method; and because it is well within the purview of choice in the art to chose on whether to form yarns by the method taught by Lofquist or other conventional yarn making methods such as ring spinning or wrap spinning, only the expected result of effectively forming a yarn having base fibers and binder fibers would have been achieved in using any one of the well known methods.

With respect to claims 2-3, since Lofquist teaches using a yarn from a base fiber prior to commingling it with binder fibers (col. 3 lines 37-41); since it is conventional in the art to form yarns by spinning a fiber bundle; and since Lofquist also teaches heating the plied yarn during the twist-setting of the plied yarn (col. 4 lines 7-29); these claims would have been obvious in the art making the synthetic yarn of Lofquist.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Sam Chuan Yao** whose telephone number is **(703) 308-4788**. The examiner can normally be reached on Monday-Thursday from 8:00 AM-5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mike Ball, can be reached on (703) 308-2058. The **fax number** in Group Art Unit 1733 for any official papers (i.e. papers that will be entered as part of the file wrapper) is **(703) 305-7718** and for unofficial papers (e.g. proposed amendments) is **(703) 305-7115**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-0651.**

Sam Chuan Yao
Primary Examiner
Art Unit 1733

scy
February 17, 2000